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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,325	08/25/2000	Andrew John Holmes	TS7564 (US)	6381

7590 03/03/2005

Kimbley L Muller
c/o Shell Oil Company
Legal Intellectual Property
P O Box 2463
Houston, TX 77252-2463

EXAMINER	
JOHNSON, JERRY D	

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/648,325	HOLMES ET AL.	
	Examiner	Art Unit	
	Jerry D. Johnson	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al in view of European Patent Application 0 434 464 A1 and Karn.

Matthews et al., U.S. Patent 4,462,918, teach lubricating oil compositions, and in particular a lubricating oil composition which may be used as a hydraulic fluid (column 1, lines 5-7). The composition comprises a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I gives improved anti-wear performance (column 1, lines 49-60). Most preferably, the Group II metal dithiophosphate is a zinc dialkyl dithiophosphate of which the alkyl groups contain 3-20 carbon atoms (column 2, lines 7-14). The combination of additives may suitably be used with other additives (column 2, lines 38-42). While Matthews et al. teach the addition of other additives, Matthews et al. differ from the instant claims in not teaching the addition of a magnesium salicylate.

European Patent Application 0 434 464 A1 (hereafter EPA '464) teach lubricant compositions especially useful as hydraulic fluids containing an amino succinate ester as corrosion inhibitor (abstract). EPA '464 teach that when used in an acidic environment, it can be desirable to incorporate, inter alia, overbased alkylsalicylate (page 3, lines 49-52).

Karn, U.S. Patent 4,627,928, is relied on as teaching overbased magnesium alkylsalicylates as additives for hydraulic fluids (column 17, lines 41-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the overbased magnesium alkylsalicylate of Karn to the lubricating composition of Matthews et al. as taught by EPA '464 and because Matthews et al. specifically teach that other additives may be incorporated into the composition of their invention.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujitsu et al. in view of Matthews et al.

Fujitsu et al., U.S. Patent 6,114,288, teach lubricating oil compositions comprising a zinc dialkyldithiophosphate and a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate (abstract). In Tables 2 and 3 of Fujitsu et al., lubricating compositions comprising magnesium salicylate, zinc dialkyldithiophosphate, defoaming agent and pour point depressant are disclosed. In column 5, lines 13-15, Fujitsu et al. specifically teach the addition of alkenyl succinic acid or ester moieties thereof as rust preventing additives for their lubricating compositions.

Matthews et al., U.S. Patent 4,462,918, teach lubricating oil compositions comprising a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I used as anti-rust agents in lubricating oil compositions gives improved anti-wear

performance (column 1, lines 49-60). The combination of additives may suitably be used with other additives (column 2, lines 38-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a compound of formula I as taught by Matthews et al. in the lubricating composition of Fujitsu et al. because Fujitsu et al. specifically teach the addition of such compounds. Additionally, one having ordinary skill in the art would have been motivated by the desire to increase the anti-wear performance of the lubricating composition as taught by Matthews et al.

Applicant's arguments filed December 10, 2004 have been fully considered but they are not persuasive.

The majority of applicants' arguments were argued in the Appeal Brief filed May 19, 2003 and the Reply Brief filed September 29, 2003. Those arguments are not persuasive for the reasons as stated in the Examiner's Answer mailed July 24, 2003 and the Decision by the Board of Patent Appeals and Interferences mailed March 31, 2004.

To the extent that applicants' arguments rely on the March 27, 2004 Declaration of Dr. Richard Dixon, applicants' arguments are not persuasive.

The Declaration of Dr. Dixon presents a legal opinion of the prior art teachings (e.g., "a skilled person would understand that it is not relevant to hydraulics and such teachings can not be translated to hydraulic fluids") and fails to set forth facts. Accordingly, the declaration is entitled to little weight.

Applicants argue

> Applicants' formulation delivers extended low wear over long period of low load (wear at idle condition) which is unexpected to a skilled person in Dr. Dixon's opinion. As stated by Dr. Dixon (page 3), applicants' claimed formulation that shows constant wear over 1000 hours and at low load condition is unexpected for a person skilled in the art. The key difference with Matthews teaching is that Application utilizes Magnesium salicylate to deliver the extended low wear over long period of low load (Remarks, page 3).

Applicants' argument lacks merit.

The burden of proving unexpected results rests on the party which asserts them. In proving such results, it is not enough just to show that certain results are obtained. The results to be probative of nonobviousness must be shown to have been unexpected to the skilled worker in the art. *In re D'Ancicco*, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971); *In re Klosak*, 455 F.2d 1077, 173 USPQ 14 (CCPA 1972); *In re Juillard*, 476 F.2d 1380, 177 USPQ 1570 (CCPA 1973). It is axiomatic that evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims the evidence is offered to support. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). Furthermore, unexpected results must be established by comparing the claimed invention against the closest prior art. *De Blauwe*, 736 F.2d at 705, 222 USPQ at 196.

Applicants refer to Table 1, found on page 12 of the specification, and state that the comparative composition (composition 2) containing calcium salicylate has significantly more ring weight loss and total weight lost than the composition as claimed n the present application containing magnesium salicylate (composition 1).

Composition 1 sets forth specific amounts of magnesium salicylate, zinc dithiophosphate and the compound of formula 1. The specific amounts, as well as the specific compounds, are not commensurate in scope with applicants' claims. Also, applicants do not explain why such

results would have been unexpected. Further, the prior art (i.e. Fujitsu et al.) teaches lubricant compositions comprising a mixture of magnesium salicylate and calcium salicylate. Accordingly, the results shown do not represent a comparison against the closest prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jerry D. Johnson
Primary Examiner
Art Unit 1764

jdj